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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/789,615	02/27/2004	Henry Earl Finley	23 - 0692	9079
40158	7590	11/01/2005	EXAMINER	
WOODS FULLER SHULTZ & SMITH P.C. ATTN: JEFFREY A. PROEHL P.O. BOX 5027 SIOUX FALLS, SD 57117			REESE, DAVID C	
		ART UNIT		PAPER NUMBER
				3677

DATE MAILED: 11/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/789,615	FINLEY, HENRY EARL	
	<b>Examiner</b>	<b>Art Unit</b>	
	David C. Reese	3677	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 15 August 2005.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-3,5-8,10 and 11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-3,5-8 and 10 is/are rejected.
- 7) Claim(s) 11 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

This office action is in response to Applicant's amendment filed 8/15/2005.

### ***Status of Claims***

- [1] Claims 1-3, 5-8 and 10 are pending.

### ***Drawings***

- [2] The drawing(s) were previously objected for informalities. In view of Applicant's amendment to the drawing to the specification submitted on 8/15/2005, all previous objection(s) to the drawings have been withdrawn.

### ***Claim Objections***

- [3] Claim(s) 2 were previously objected to because of informalities. Applicant has successfully addressed these issues in the amendment filed on 8/15/2005. Accordingly, the objection(s) to the claim(s) have been withdrawn.

With further examination of said claims, however, a new claim objection has been found regarding the claim terminology used to describe the relationship of the ear adornment and the user. In line 3, Claim 1, for example, "engaging the ear of the user;" should be changed to: "engaging an ear of a user;" regardless of its dependence from the preamble, as to deter possible non-statutory subject matter issues; especially when referring to "the ear." Thus, the examiner asks the applicant's cooperation in maintaining each of the above in the following claims: 1, 3, 5, 8, and 11.

Also, in line 6, in claim 1 consider changing the statement to read as follows: "member such that said sleeve member is positioned..." as to help ensure the definiteness of the instant statement.

***Claim Rejections - 35 USC § 102***

- [4] The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

- [5] Claims 1, 3 and 10 are rejected under 35 U.S.C. 102(b) as clearly anticipated by Alviti, US- 5,079,933, because the invention was patented or described in a printed publication in this or a foreign country, or in public use or on sale in this country more than one (1) year prior to the application for patent in the United States.

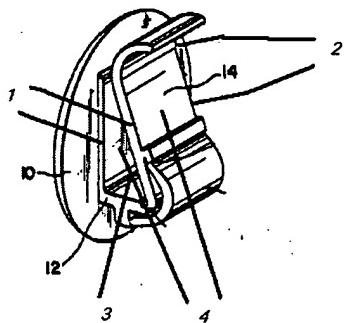
As for Claim 1, Alviti teaches of an ear adornment for adorning an ear of a user, the ear adornment comprising (see accompanying figure below):

a frame member (12) for selectively engaging the ear of the user; and  
a sleeve member (10) being removably coupled (the ornament 10 is able to be removed) to said frame member (12) such that said sleeve member (10) for being positioned adjacent the

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ear of the user when the frame member (12) engages the ear of the user, to provide the user with a unique appearance when said sleeve member (10) is coupled to said frame member (12);

wherein said frame member (12) comprises a pair of substantially U-shaped engaging portions (1,2) each having a throat (3) for receiving an upper periphery of the ear of the user, the engaging portions (1,2) each having ends that extend over the ear when said frame member (12) is engaged with the ear, said frame member (12) further comprising a pair of alignment portions (4) extending between corresponding said ends of the engage portions (1,2) to join said pair of engaging portions (1,2) together such that said pair of engaging members (1,2) and said pair of alignment member (4) from a continuous loop.



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Re: Claim 3, wherein each of said engaging portions (1,2) comprises a resiliently flexible material (col. 2, beginning with line 43), permitting each of said engaging portions (1,2) to substantially conform to a general shape of the ear when each of said engaging portions (1,2) extends from a front to a back of the ear.

Re: Claim 10, wherein said throat (3) formed by said engaging portions (1,2) has a substantially uniform width and extends along a single axis.

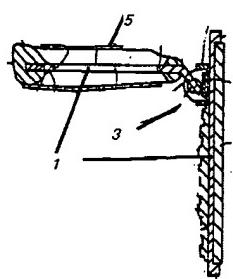
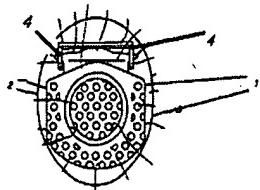
[5] Claims 1-2, 6-8 are rejected under 35 U.S.C. 102(b) as clearly anticipated by Matsushita, US- 5,085,060, because the invention was patented or described in a printed publication in this or a foreign country, or in public use or on sale in this country more than one (1) year prior to the application for patent in the United States.

As for Claim 1, Matsushita teaches of an ear adornment for adorning an ear of a user, the ear adornment comprising (see accompanying figure below):

a frame member (1) for selectively engaging the ear of the user; and  
a sleeve member (5) being removably coupled to said frame member (1) such that said sleeve member (5) for being positioned adjacent the ear of the user when the frame member (1) engages the ear of the user, to provide the user with a unique appearance when said sleeve member (5) is coupled to said frame member (1);

wherein said frame member (1) comprises a pair of substantially U-shaped engaging portions (1,2) each having a throat (3) for receiving an upper periphery of the ear of the user, the engaging portions (1,2) each having ends that extend over the ear when said frame member (1) is engaged with the ear, said frame member (1) further comprising a pair of alignment portions (4) extending between corresponding said ends of the engage portions (1,2) to join said pair of

engaging portions (1,2) together such that said pair of engaging members (1,2) and said pair of alignment member (4) from a continuous loop.



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Re: Claim 2, wherein said sleeve member (5) forms a sleeve with an upper open end (11A) and a lower open end and an interior therebetween (16), the upper open end of said pocket removably receiving a portion of each of said engaging members (1,2).

Re: Claim 6, further comprising:

said sleeve (5) member comprising a perimeter wall (15B), said perimeter wall (15B) defining a receiving bore (16) extending through said sleeve (5) member, said perimeter wall (15B) including a pair of opposed wall portions (15B, 15D), each of said opposed wall portions having a protrusion (15G in Fig. 3), each of said protrusion (15G) extending in opposition to said protrusion (15G) on the opposite one (15D) of said opposed wall portions (15B, 15D).

Re: Claim 7, further comprising:

said sleeve member (5) comprising a flexible material, said flexible material permitting said sleeve member (5) to conform to the portion of said frame member (1) received by said sleeve member (5) when said sleeve member (5) receives said frame member (1).

Re: Claim 8, further comprising:

an adornment member (15C) being selectively coupled to said sleeve member (5), said adornment member (15C) being suspended from said frame member (1) when said sleeve member (5) is coupled to said frame member (1), said adornment member (15C) being adapted for adorning the ear of the user when said frame member (1) engages the ear of the user.

***Claim Rejections - 35 USC § 103***

[6] The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

[7] Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Alviti, US-5,079,933, in view of Zubalik, US 2,803,953.

Although the invention is not identically disclosed or described as set forth 35 U.S.C. 102, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a designer having ordinary skill in the art to which said subject matter pertains, the invention is not patentable.

As for Claim 5, Alviti teaches of the above claims.

However, Alviti fails to disclose expressly that the ear adornment is held in place by magnetic attraction.

Zubalik teaches of an earring that provides means whereby the earrings are held in place by magnetic attraction.

At the time of invention, it would have been obvious to one of ordinary skill in the art to modify the mechanical ear adornment as taught by Alviti, to incorporate an embodiment as taught by Zubalik, in order to as Zubalik states in column 1, "It is an object of this invention to provide an earring which may be accommodated to a non-pierced ear and which does not utilize

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either a hook or a clamp or other type of mechanical clamping elements.” Continuing with column 2, line 33, “Aside from presenting unsightly impedimenta, these clamping means are frequently irritating to the ear. The magnetic members form a comfortable...” Thus it is obvious to discern why one would prefer to use magnets instead of other mechanical means.

***Allowable Subject Matter***

[8] Claim 11 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Reasons for Allowance***

[9] The following is an examiner’s statement of reasons for allowance: the prior art, either alone or in combination with corresponding limitations as stated above, fails to teach or disclose the exact combination of features as stated in the instant claim.

Any comments considered necessary by Applicant must be submitted no later than the payment of the issue fee, and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled “Comments on Statement of Reasons for Allowance.”

***Response to Arguments***

[10] Applicant’s amendment, see amendment and remarks filed 8/15/2005, with respect to the rejection(s) of claim(s) 1-4, 6-8 under Kohler, US- 2,490,908, have been fully considered. Therefore, the rejection with regard to Kohler has been withdrawn. However, upon further consideration of the amended claims, a new ground(s) of rejection is made in view of Alviti and then Matsushita.

***Conclusion***

[11] Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

[12] Any inquiry concerning this communication or earlier communications from the examiner should be directed to David C. Reese whose telephone number is (571) 272- 7082. The examiner can normally be reached on 7:30 am - 6:00 pm M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J.J. Swann can be reached at (571) 272-7075. Please also note the change in the fax phone number to (571) 273-8300 for the organization where this application or proceeding is assigned.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sincerely,  
David Reese  
Assistant Examiner  
Art Unit 3677

DCR

  
ROBERT J. SANDY  
PRIMARY EXAMINER